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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,068	03/26/2004	Malcolm H. Davis	13768.502	3512

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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT PAPER NUMBER

2134

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/810,068

Applicant(s)

DAVIS ET AL.

Examiner

Michael J. Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 31-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12-17, 20-23, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 7-11, 18, 19 and 24-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/26/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The IDS of 3/26/2004 was received and considered.
2. Claims 1-38 are pending.

***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-30, drawn to making and using publishing and message server use licenses to perform actions on messages, classified in class 726, subclass 29.
  - II. Claims 31-38, drawn to comparing message policies for compatibility, classified in class 726, subclass 1.

4. The inventions are distinct, each from the other because:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because licensing to view messages can be performed without first determining compatibility, as evidenced by independent claims 1, 13 and 21. The subcombination has separate utility such as determining compatibility to enhance security.

5. Claims 7 & 24 link(s) inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 7 & 24. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be

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withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

6. During a telephone conversation with Michael Dodd (801-533-9800) on 1/12/2006 a provisional election was made without traverse to prosecute the invention of group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6, 12-17, 20-23 & 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2005/0138353 to Spies et al. (**Spies**).

Regarding claims 1-3 & 20-22, Spies discloses receiving data including a message with a protected/encrypted portion (Fig. 6), a publishing license/encrypted symmetric message key (¶47) and a message server use license/encrypted symmetric message key (¶47), the protected portion of the message controlled by a rights management server/sender (¶47) (or private key generator, ¶95), the publishing license/encrypted symmetric message key (¶47) defining one or more principals' rights to the protected portion of the message (right to read) (¶47), and the message server use license/encrypted symmetric message key (¶47) comprising an encrypted key that corresponds to an entity's/organization's message server/gateway (¶47 & ¶56), using the message server use license/encrypted symmetric message key (¶47) to access the protected portion of the message for performing operations/virus scan on the protected portion in accordance with message policies defined by the entity/organization (¶56) and making the message and the publishing license available (forwarding) to the one or more principals (¶56) when the protected portion of the message conforms to the message policies defined by the entity (¶56 & ¶¶93-94).

Regarding claims 4, 17 & 23, Spies discloses the operations being performed by a sending entity's server/gateway before sending the message and the publishing license to a partner entity/recipient (¶88 & ¶119).

Regarding claims 5 & 29, Spies discloses the operation being performed by a partner (third party or recipient) entity's server/gateway when receiving the message from a sending entity (¶91 & ¶130).

Regarding claim 6, Spies discloses the message server use license including the rights available to the partner entity's server (right to read) (§47).

Regarding claims 12 & 30, Spies discloses a process (sender/receiver), user (sender/receiver), machine, server or client (sender/receiver and message server/third party) (§47 & §130).

Regarding claims 13-15, Spies discloses receiving a request for a message server use license/encrypted symmetric message key (§47) that identifies an entity's message server (addressed to an organization) (§47 & §91), receiving a key that allows access to a protected portion of a message controlled by a rights management server/sender (§47) (or private key generator, §95), encrypting the key to correspond with the entity's message server/gateway (§47 & §56) and generating a message server use license that includes the encrypted key/encrypted symmetric message key (§47) for allowing the entity's/organization's message server/gateway access to the protected portion of the message when performing operations on the message in accordance with message policies defined by the entity/organization (§56 & §§93-94).

Regarding claim 16, Spies discloses the entity being the sending entity (§88 & §§93-94).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1-6, 12-17, 20-22 & 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0007456 to Peinado et al. (**Peinado**) in view of **Spies**.

Regarding claims 1-3, 6 & 12-16, Peinado discloses receiving a request for a message server use license/rendering license (§10 & §§154-162) that identifies an entity's/user's message server/DRM system (§§155-156), receiving a key (§159) & §164) that allows access to a protected portion of a message/content (§158) controlled by a rights management server/license server (§154), encrypting the key to correspond with the entity's/user's message server/DRM system (§175) and generating a message server use license/license (§§172-177) that includes the encrypted key for allowing the entity's/user's message server/DRM system access to the protected portion of the message/content when performing operations on the message (decryption) (§143). Peinado is silent regarding performing operations on the message in accordance with message policies defined by the entity and is silent on the DRM system being a message server. However, Spies teaches that remotely-hosted third-party services are available for blocking viruses (§§2-3) (such as a gateway/message server that scans for viruses, §§11-12), but because some email is encrypted, businesses need to use software that is capable of handling both unencrypted and encrypted messages (§§2-3). Spies's system encrypts, at the sender, a message with a message key and sends the encrypted message with the message key encrypted under a receiver's public key (§47 & §55). The receiving gateway decrypts the message, scans it for viruses, and re-encrypts it for the receiver (§56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peinado to employ the DRM system on a message server in accordance with the messaging system of Spies,

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which performs operations (virus scan) on messages according to the user's organization's policy. One of ordinary skill in the art would have been motivated to perform such a modification to scan for viruses in encrypted mail, as taught by Spies (¶¶2-3, 11-12, 47 & 55-56).

Regarding claims 4 & 17, Peinado, as modified above, discloses the entity being the sending entity (Spies, ¶¶88 & ¶¶93-94).

Regarding claims 5 & 29, Peinado, as modified above, discloses the operations being performed by a partner entity's server/third party message processing server when receiving the message from the sending entity (Spies, ¶¶91).

Regarding claims 20-22, Peinado discloses receiving a message/content (¶158) with a protected portion being controlled by a rights management server/license server (¶154), receiving a publishing license/license that includes rights available to one or more intended principals/user (¶174), the rights controlling the type of operations that can be performed on the protected portion of the message (¶174), requesting a message server use license/license to allow access to the protected portion of the message (¶154 & ¶¶172-177), receiving the requested message server use license (¶179), the requested message server use license including an encrypted key that corresponds to the entity (¶175) and making the message, publishing license and message server use license available to the entity (¶179). Peinado lacks the steps performed at an entity's message server, lacks receiving message policies defined by an entity, which specify operations that are to be performed on the message and receiving an encrypted key that corresponds to the entity's message server. However, Spies teaches that remotely-hosted third-party services are available for blocking viruses (¶¶2-3) (such as a gateway/message server that scans for viruses,



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¶¶11-12), but because some email is encrypted, businesses need to use software that is capable of handling both unencrypted and encrypted messages (¶¶2-3). Spies's system encrypts, at the sender, a message with a message key and sends the encrypted message with the message key encrypted under a receiver's public key (¶¶47 & ¶¶55). The receiving gateway decrypts the message, scans it for viruses, and re-encrypts it for the receiver (¶¶56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peinado to employ the DRM system on a message server in accordance with the messaging system of Spies, which performs operations (virus scan) on messages according to the user's organization's policy, thus performing the acts at an entity's/organization's message server, receiving message policies defined by an entity, which specify operations that are to be performed on the message and receiving an encrypted key that corresponds to the entity's message server. One of ordinary skill in the art would have been motivated to perform such a modification to scan for viruses in encrypted mail, as taught by Spies (¶¶2-3, 11-12, 47 & 55-56).

***Allowable Subject Matter***

11. Claims 7-11, 18-19 & 24-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. U.S. Patent Application Publication 20040125798 to Hondo et al. is cited for teaching comparing privacy policies for compatibility (10), but lacks motivation to combine this feature with the teachings of Spies and Peinado.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Publication 2002/0007453 to Nemovicher is cited for teaching the interception, decryption, authentication, timestamp, virus check, re-encryption and transmission of secure mail (encrypted).
- b. Publication 2004/0193915 to Smith et al. is cited for teaching interacting with a sender of a secure package and applying a policy established by the sender.
- c. Publication 20040125798 to Hondo et al. is cited for teaching comparing privacy policies for compatibility (§10).
- d. The references to Bandini, Herrmann, Liu, Miller & Minnig are cited for teaching a gateway for applying policies to messages.
- e. Publication 2005/0097359 to Speare et al. is cited for teaching an entity's message server acquiring a license on behalf of the entity.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached at (571) 272-6962.

**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**Or faxed to:**

(571) 273-8300

(for formal communications intended for entry)

**Or:**

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJS



May 17, 2006

